

Appl. No. 10/822,262
Amtd. Dated 10/15/05
Reply to Office Action of 07/15/05

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application.

Evan et al.'s blades 126 do not extend outwardly, as Applicant's blades are claimed in the independent claims. Evan et al. teaches away from extending its blades outwardly because its bearing elements 32 would be dislodged from the shank 112 (see FIGS. 2-4). That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Neither Evans et al. nor Singh teaches a plurality of notches, as claimed in Applicant's independent claims. In fact, Evans et al. teaches away from forming notches in its outer surface because it employs the use of a hard facing material 34 which holds the elements 32 to the outer bearing surface 30 without damages or cutting notches into the outer bearing surface 30 (see column 7, lines 11-23). Furthermore, Evans et al. does not have a need for notches because it would reduce the stability of its gauge portion 14 (see column 6, lines 53-65). Bearing elements 32 lie on the outer bearing surface 30 of the gauge portion 14 of the drill bit and spaces between adjacent bearing elements 32 are filled with the settable hard facing material 34 (see column 7, lines 11-14).

A person of ordinary skill in the art would not combine Singh's teachings with Evans et al. because Evans et al. specifically teaches away from employing a less durable carbide button, as recited in Applicant's independent claims. Evans et al. specifically states that a carbide composite should only be used as the settling agent to keep the harder and more durable TSP attached to its gauge portion 14 (see column 2, lines 20-58). It is well known in the industry that TSP is a superior product to any tungsten composite and, therefore, a person of ordinary skill in the art would not employ Applicant's tungsten carbide in lieu of TSP. This statement is confirmed by Evans et al. in column 2, lines 2-33, which states, "a material which is significantly more wear-

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resistant than tungsten carbide, and is also available in the form of rectangular blocks or tiles, is thermally stable polycrystalline diamond (TSP). As is well known, thermally stable polycrystalline diamond is a synthetic diamond material which lacks the cobalt which is normally present in the polycrystalline diamond layer of the two-layer compacts which are frequently used as cutting elements for rotary drag-type drill bits. The absence of cobalt from the polycrystalline diamond allows the material to be subjected to higher temperatures than the two-layer compacts without sufficient significant thermal degradation, and hence the material is commonly referred to as "thermally stable", (see column 2, lines 20-33).

Accordingly, a person of ordinary skill in the art would not substitute carbide composites for Evan et al.'s TSP. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the above mentioned arguments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

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